

## **II. A Response to the Office Action:**

### **A. Status of the Claims**

Claims 1-32 were pending upon the issuance of the Office Action dated May 5, 2004. Claims 3 and 9 have been amended and claims 26 and 27 have been canceled. Claims 1-25 and 28-32 are therefore pending.

### **B. The Enablement Rejection Is Overcome**

The Action rejects claim 3 under 35 U.S.C. § 112, first paragraph, for lack of enablement. The Action contends that claim 3 is not commensurate in scope with an enabling disclosure. At the suggestion of the Action, Applicants note that claim 3 now recites, in part, “wherein R is an alkyl group or phenyl group... .” The present enablement rejection should therefore be withdrawn.

Applicants would like to make it clear, however, that they traverse the Action’s rejection of original claim 3 for lack of enablement under 35 U.S.C. § 112, first paragraph. A person of ordinary skill in the art would be able to make and use a substituted alkyl group or phenyl group based on the teachings in the specification and the knowledge of a person of ordinary skill in the art. *See United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation.”); *see also* MPEP § 2164.01. For example, it is well known that alkyl groups and phenyl groups can be substituted with any number of molecules. Substituting such groups is standard chemistry that is disclosed in classroom textbooks—it is routine in the art and can be done without undue experimentation. *See Manual of Patent Examining Procedure* (MPEP) § 2164.03 (8<sup>th</sup> ed. rev. no. 1, 2003) (noting that “[t]he amount of guidance or direction needed to

enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art.”). Additionally, in non-limiting embodiments, examples 1-9 of the present specification disclose how to make and use the present invention. The present enablement rejection, therefore, cannot be maintained. *See* MPEP § 2164.04(b) (noting that “[a]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112 is satisfied.”).

Further, the Action appears to support its enablement rejection by taking the position that the specification does not teach how to select molecules that can be used as substituted groups on an alkyl or phenyl group. *See* the Action, page 2. This contention is incorrect. As noted above, examples 1-9 of Applicants’ specification teaches how to make and use the present specification. It is also routine in the art to substitute both alkyl and phenyl groups with a number of different molecules. The Action, in fact, fails to provide any evidence to the contrary. *See* MPEP § 2164.04 (“In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.”). Based on the teaching of the specification alone, or in combination with the knowledge of a person of ordinary skill in the art, the present claims are enabled. Therefore, present claim 3, as amended, encompasses both substituted and non-substituted alkyl or phenyl groups. Applicants also note that the MPEP states that “[t]he specification need not contain an example if the invention is otherwise disclosed in such a manner that one skilled in the art will be able to practice it without an undue amount of experimentation.”); MPEP § 2164.02; *see also Atlas Powder Co. v. E.I. duPont De Nemours & Co.*, 750 F.2d 1569, 1576, 224 U.S.P.Q. 409 (Fed. Cir. 1984) (noting that the satisfaction of the enablement requirement is not precluded by the necessity of some

experimentation.); MPEP § 2164.01 (“The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.”).

The rejection of claim 3 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

**C. The Anticipation and Obviousness Rejections are Moot**

The Action rejects claims 26 and 27 under 35 U.S.C. § 102(b) as being anticipated by, or rendered obvious under 35 U.S.C. § 103(a) over, Keita *et al.* or EP 0 942 027. Applicants note that claims 26 and 27 have been canceled, thus rendering these rejections moot. Applicants reserve all rights to pursue the subject matter of these claims in future continuing applications.

**D. Conclusion**

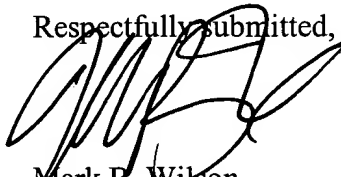
Applicants believe that the present document is a full and complete response to the Office Action dated May 5, 2004 and submit that the present case is in condition for allowance.

**III. A Petition For A Three-Month Extension of Time:**

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of three month to and including November 5, 2004, in which to respond to the Office Action dated May 5, 2004. Pursuant to 37 C.F.R. § 1.17, a check in the amount of \$980.00 is enclosed, which is the process fee for a three-month extension of time for a large entity status. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/ESSR:049US.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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